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Remarks

This is in response to the Advisory Action mailed on June 20, 2005. Claims 27, 29, 30, 32-48, and 50-59 remain pending, with claims 27, 30, 33, 36, 46, 48, 53, and 59 being independent. Reconsideration and allowance are respectfully requested for at least the following reasons.

I. Claim Rejections - 35 U.S.C. § 103

Claims 27, 29, 30, 32, 36-45, 48, 50, 52, 53, and 55-59 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimek et al., U.S. Patent No. 5,941,237, in view of Moore et al., U.S. Patent No. 3,758,317. This rejection is respectfully traversed, and the correctness of the rejection is not conceded. Reconsideration is requested for at least the following reasons.

Applicants do not concede that there is any motivation to combine Shimek and Moore for at least the reasons provided in the Amendment filed on February 21, 2005. Applicants therefore respectfully do not concede that the rejection articulates a *prima facie* case of obviousness.

However, assuming for the purposes of this response only that the rejection does state a *prima facie* case of obviousness, it is respectfully suggested that the evidence of secondary considerations presented in the Amendment filed on February 21, 2005 has not been properly considered as evidence of nonobviousness.

A. The Advisory Action Misapprehends the Import of the Secondary Evidence

The Advisory Action states that the Rule 132 declaration by David C. Lyons, executed on February 17, 2005 and filed with the Amendment on February 21, 2005 ("Lyons Rule 132 Declaration") fails to render the claims "free from the prior art." The Action finds that the Lyons Rule 132 Declaration fails to present evidence of "long-felt but unsolved need" because it does not refer to or address the compression molding technique in Moore et al., U.S. Patent No. 3,758,317. It is respectfully suggested for the following reasons that the Advisory Action misapprehends the import of the Lyons Rule 132 Declaration.

Evidence of secondary considerations, such as long-felt need, must be weighed as a whole, rather than applied specifically to a prior art rejection. *In re Eli Lilly*, 902 F.2d 943 (Fed. Cir. 1990); *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984); MPEP 706.01(d). For example, the Federal Circuit reversed the Board's finding of obviousness in *Piasecki* because the Board

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misinterpreted and misapplied the evidence of secondary considerations presented by the applicant. Piasecki, 745 F.2d at 1475. Specifically, the Court found that the Board erred for "criticizing the [evidence of secondary considerations] for failure to discuss the prior art." Id. at 1471. The Court instead found that evidence such as long-felt need must be considered as a whole and applied as rebuttal evidence against the *prima facie* case of obviousness. Id. at 1472. The fact finder must not view the evidence "solely 'on its knockdown ability.'" Id. at 1473.

In the present application, the Lyons Rule 132 Declaration presents evidence of a long-felt persistent need recognized in the fireplace industry for a burner or a fireplace including a burner panel that exhibits both structural integrity and malleability. In examining others failed attempts to meet this recognized need, the Lyons Rule 132 Declaration describes the burners disclosed in Shimek et al., U.S. Patent No. 5,941,237, and Sinsley, U.S. Patent No. 6,361,725. The discussion of these two references is included not to knockdown these two references from consideration as prior art, but instead to describe previous failed attempts at solving the long-felt need identified in the Lyons Rule 132 Declaration.

The Lyons Rule 132 Declaration is submitted as evidence of long-felt need to rebut the *prima facie* case of obviousness, not as evidence to "knockdown" Moore from consideration as prior art. It is therefore respectfully suggested that the Advisory Action falls into the trap identified by the Federal Circuit in Piasecki when it examines the Lyons Rule 132 Declaration solely for its ability to remove Moore from consideration as prior art. It is instead respectfully requested that the evidence presented in the Lyons Rule 132 Declaration be considered as rebuttal evidence against the *prima facie* case of obviousness.

B. The Advisory Action Fails to Identify Any Insufficiency in the Evidence of Secondary Considerations

If evidence of secondary considerations is insufficient to overcome a *prima facie* case of obviousness, the rejection must specifically state why the evidence is insufficient. MPEP 716.01. General statements of inadequacy or summary dismissal of such evidence without a detailed explanation are improper. Id.; see also MPEP 2144.08(II)(B).

The Advisory Action states that the disclosure of compression molding for burner components in Moore outweighs the evidence of non-obviousness of record for the present application. It is unclear what "evidence" is considered when this statement is made. Further,

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the Advisory Action fails to specifically identify any insufficiency in the evidence of long-felt need articulated in the Lyons Rule 132 Declaration. It respectfully suggested for the following reasons that the evidence of long-felt need rebuts the *prima facie* case of obviousness.

C. Secondary Consideration - Long-Felt Need

Evidence of long-felt need must include the following indicia: (i) recognized problem - an art recognized problem exists in the art for a long period of time without solution; (ii) problem not previously satisfied - long-felt need has not been satisfied by another before the invention; and (iii) invention solves problem - the invention must in fact satisfy the long-felt need. MPEP 716.04(I).

The Rule 132 declaration by David C. Lyons, executed on February 17, 2005 and filed with the Amendment on February 21, 2005 ("Lyons Rule 132 Declaration"), provides evidence of a long-felt but unsolved need. Specifically, the Lyons Rule 132 Declaration illustrates all of the indicia required by the law as summarized at MPEP 716.04(I):

- (i) recognized problem - there was a long-felt persistent need recognized in the fireplace industry for a burner or a fireplace including a burner panel that exhibited both structural integrity and malleability to allow for the burner panel to be manipulated after forming - see ¶¶ 4 and 7 of the Lyons Rule 132 Declaration;
- (ii) problem not previously satisfied - problems associated with prior molding techniques such as vacuum molding (Sinsley) and casting (Shimek et al.) did not solve the persistent need - see ¶¶ 5 and 6 of the Lyons Rule 132 Declaration; and
- (iii) invention solves problem - burner panels including a compression molded material as recited in the rejected claims have greater strength and malleability and therefore squarely address the long-felt persistent need - see ¶¶ 8-10 of the Lyons Rule 132 Declaration.

It is respectfully requested that this evidence be considered in view of the contention in the rejection that the rejected claims are obvious over the combination of Shimek and Moore. When the evidence of "secondary considerations" is weighed against the factors relating to the establishment of an alleged *prima facie* case of obviousness, it is apparent that the rejected claims are not obvious in light of the combination of Shimek and Moore. In light of the long-felt need in the industry, these claims cannot be said to be obvious over the recited patents, since any

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such "obvious" solution would have been implemented long ago in light of the above-described long-felt need - for example, Moore issued over three decades ago.

Reconsideration and allowance of claims 27, 29, 30, 32, 36-45, 48, 50, 52, 53, and 55-59 are therefore respectfully requested.

II. Allowable Subject Matter

Claims 33-35, 46, 47, 51, and 54 are noted as containing allowable subject matter. Applicants appreciate the Examiner's assistance in identifying allowable subject matter. All claims are in condition for allowance.

III. Conclusion

The remarks set forth above provide certain arguments in support of the patentability of the pending claims. There may be other reasons that the pending claims are patentably distinct over the cited references, and the right to raise any such other reasons or arguments in the future is expressly reserved.

In view of the above amendments and remarks, Applicant respectfully requests examination and a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,
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Date: Aug 2, 2005

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